

REMARKS / DISCUSSION OF ISSUES

Claims 1-14 and 38-53 are pending in the application; claims 38-53 are newly added. Claims 14 and 38-53 are herein withdrawn from consideration, being drawn to a non-elected species. Claim 1 is generic to all of the pending claims, and upon allowance, the withdrawn claims will be reinstated.

The applicants thank the Examiner for acknowledging the claim for priority and receipt of certified copies of all the priority document(s), and for determining that the drawings are acceptable.

Claims are amended for non-statutory reasons: to correct one or more informalities, remove figure label number(s), and/or to replace European-style claim phraseology with American-style claim language.

The Office action notes that claim 14 is drawn to a non-elected species; claim 14 is herein withdrawn from consideration on the merits.

The Office action rejects claims 1-13 under 35 U.S.C. 112, second paragraph; claims 1, 6, 10, and 13 are correspondingly amended herein. The applicants respectfully traverse this rejection with respect to claim 9.

Claim 9 recites that the outer sheath is formed from a substantially flexible polymer. The courts have repeatedly held that words of approximation may be used in claims. In Cordis Corp. v. Medtronic AVE, Inc., 339 F.3d 1352, 1361 (Fed. Cir. 2003), the court refused to impose a precise numeric constraint on the term "substantially uniform thickness," noting that the proper interpretation of this term was "of largely or approximately uniform thickness" unless something in the prosecution history imposed the "clear and unmistakable disclaimer" needed for narrowing beyond this plain-language interpretation. Id. Moreover, in Anchor Wall Sys. v. Rockwood Retaining Walls, Inc., 340 F.3d 1298 (Fed. Cir. 2003), the court held that "the phrase 'generally parallel' envisions some amount of deviation from exactly parallel," and that "words of approximation, such as 'generally' and 'substantially,' are descriptive terms 'commonly used in patent

claims' to avoid a strict numerical boundary to the specified parameter.'" Id. at 1311. Accordingly, the applicants respectfully maintain that the rejection of claim 9 under 35 U.S.C. 112, second paragraph, is improper, and should be withdrawn.

The Office action rejects claims 1-10 and 12 under 35 U.S.C. 103(a) over Akashi (USP 6,287,485) and Shibahashi (USP 4,681,791), and claims 1-13 under 35 U.S.C. 103(a) over Akashi, Shibahashi, and Kochman (USP 5,824,996). The applicants respectfully traverse this rejection.

The combination of Akashi, Shibahashi, and Kochman fails to teach or suggest a filament or fiber that includes an inner electrode that is axially located within an elongated core and configured to stimulate a volume modulation coloration producing substance in the core to produce a change in the volume of the substance, thereby changing the color of the filament or fiber, as specifically claimed in claim 1, upon which claims 2-13 and 38-53 depend.

Akashi teaches elements 22 on the substrates 24 that form the core in which the volume modulation coloration producing substance is located, and does not teach or suggest an axially located electrode within an elongated core. Shibahashi does not address electrodes, and Kochman does not address a volume modulation coloration producing substance. As such, it cannot be said that the combination of Akashi, Shibahashi, and Kochman teaches an axially located electrode within an elongated core, as taught and claimed by the applicants. Given that Akashi teaches electrodes at the periphery of the color producing substance, and Shibahashi does not teach electrodes, the combination of Akashi and Shibahashi cannot be said to suggest adding an axially located electrode in a core of color producing substance to Akashi. Given that Akashi teaches electrodes at the periphery of the color producing substance, and Kochman does not teach a color producing substance, the combination of Akashi and Kochman cannot be said to suggest adding an axially located electrode in a core of color producing substance to Akashi.

In KSR Int'l. Co. v. Teleflex, Inc., the Supreme Court noted that the analysis supporting a rejection under 35 U.S.C. 103(a) should be made explicit, and that it is

"important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements" in the manner claimed:

"Often, it will be necessary ... to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an **apparent reason** to combine the known elements **in the fashion claimed by the patent at issue**. To facilitate review, this analysis **should be made explicit.**" KSR, slip op. at 14 (emphasis added).

There is no suggestion that the simple placement of electrodes on a substrate as taught by Akashi is deficient in any manner, and therefore there is no apparent reason for one of skill in the art to modify Akashi to place an electrode at an axial location within an elongated core, and neither Shibahashi nor Kochman provides an apparent reason for modifying Akashi to provide an axially located electrode, as specified in the applicants' claims.

The Office action asserts that "it would be obvious to one having ordinary skill in the art to locate the heating element in any suitable location". The applicants respectfully maintain that such an assertion does not satisfy the criteria of providing an explicit analysis of where the prior art provides an apparent reason for modifying the prior art in the fashion claimed by the applicants, as required under the principles expressed by the Supreme Court in *KSR*. Contrarily, because the creation of an axially located conductor in a core of color producing substance, as claimed, is conventionally substantially more difficult than merely providing electrodes on a flat substrate that forms a core, as taught by Akashi, one of skill in the art would have no apparent reason to introduce this more complex structure in Akashi.

Because the combination of Akashi, Shibahashi, and Kochman fails to teach or suggest a filament or fiber that includes an inner electrode that is axially located within an elongated core and configured to stimulate a volume modulation coloration producing substance in the core, the applicants respectfully maintain that the rejection of claims 1-13 under 35 U.S.C. 103(a) over Akashi, Shibahashi, and Kochman is unfounded, and should be withdrawn.

In view of the foregoing, the applicants respectfully request that the Examiner withdraw the objection(s) and/or rejection(s) of record, allow all the pending claims, and find the application in condition for allowance. If any points remain in issue that may best be resolved through a personal or telephonic interview, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,

/Robert M. McDermott/

Robert M. McDermott, Esq.  
Reg. 41,508  
804-493-0707

**Please direct all correspondence to:**  
Corporate Counsel  
U.S. PHILIPS CORPORATION  
P.O. Box 3001  
Briarcliff Manor, NY 10510-8001